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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/719,272 | 05/04/2001 | Hiroshi Yamamoto | 19036/36959 | 7004 |

7590

08/13/2002

David A Gass
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EXAMINER

DAVIS, NATALIE A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1642

DATE MAILED: 08/13/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,272

Applicant(s)

YAMAMOTO ET AL.

Examiner

Natalie A. Davis

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 20-26 and 29-39 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 11, 14 and 16-18 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-10, 12, 13, 15, 19, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

1. Applicant's amendment filed 30 May 2002 (Paper No: 17) is acknowledged. Accordingly, claims 4 and 6 are amended, claims 20-26 and 29-39 are withdrawn from examination as being drawn to a non-elected invention, and claims 1-19 and 27-28 are under examination.

Response to Arguments

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112 1st Withdrawn

3. Rejection of claims 11 and 14 under 35 U.S.C. 112, first paragraph is withdrawn in view of declaration disclosing the biological deposit of biological material.

Claim Rejections - 35 USC § 112 2nd Withdrawn

4. Rejection of claims 1-4 under 35 U.S.C. 112, second paragraph is withdrawn in view of amendments.

Claim Rejections - 35 USC § 112 1st Withdrawn

5. Rejection of claims 4 and 6 under 35 U.S.C. 112, first paragraph is withdrawn in view of amendments.

Claim Rejections - 35 USC § 102 Maintained

6. Rejection of claims 1, 4-10, 12-13, 15, 19, and 27-28 over Streuli, et al. (1992) under 35 U.S.C. 102(b) is maintained for reasons set forth in the previous office action. The traversal is on the grounds that Streuli does not teach isolation of antibodies specific for LAR phosphatase subunits, the antibodies reported were targeted against the 150 kDa extracellular domain of LAR, and the 85 kDa protein band was only "immunoprecipitated." One would not interpret the article as disclosing any antibodies with "immunospecificity" for the 85 kDa subunit. Applicant's arguments have been considered but are not persuasive because applicant has not indicated what

"specificity" means. In addition, Streuli teaches an antibody that binds to a LAR protein (150 kDa, designated LAR E-subunit) with the same molecular weight as the instant invention. Accordingly, it would be reasonable to conclude that the antibody(s) taught by Streuli anticipates the invention as claimed because it teaches an antibody that binds to a LAR subunit, which possesses the same molecular weight and is shown to be linked with medullary thyroid cancer. Furthermore, claims 7-10 are product by process of making an antibody and carry no patentable weight.

Claim Rejections - 35 USC § 103 Withdrawn

7. Rejection of claims 1-10, 12-13, 15-19, and 27-28 over Streuli, et al. (1988, 1992, and 1990) in view of Furukawa, et al. (1994) under 35 U.S.C. 103(a) is withdrawn in view of arguments.

Claim Rejections - 35 USC § 102

8. Claim 2 is rejected under 35 U.S.C. 102(b) *as being anticipated by applicants' admission on page 6 lines 21-24 of the specification.*
~~based upon a public use or sale of the invention.~~

Claim 2 is drawn to an antibody with specificity to an intracellular domain of a LAR phosphatase subunit. Figure 1 illustrates that the LAR phosphatase intracellular subunit comprises domain 1. The specification discloses known antibodies to protein tyrosine phosphatase, including an antibody generated from the transmembrane region of CD45 to a part of phosphatase domain 1 (Transduction Laboratories) (p. 6). Accordingly, the specification anticipates the invention as claimed and indicates that claimed antibodies are for public use and sale by Transduction Laboratories.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Davis whose telephone number is 703-308-6410. The examiner can normally be reached on M-F 8-5:30 (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa PhD can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4315 for regular communications and 703-308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Natalie A. Davis, PhD
August 9, 2002


SHEELA HUFF
PRIMARY EXAMINER